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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/761,031

Applicant(s)

ROWE, RICHARD E.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### ***DETAILED ACTION***

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 20, 2003 has been entered.

#### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnieder et al., U.S. Patent 6,089,976 (Jul. 18, 2000)

Regarding claims 1, 9, 17 and 34: *Schneider* disclose a slot machine that teaches the following features of the claims:

- a. A display unit capable of generating images associated with a main gambling game and bonus round game. *See fig. 16(14, 16); col. 4:28-46*. It is implicit that the display is a color display.
- b. An input device allowing the user to make a plurality of input selections. *See fig. 6(14, 16), 26*.
- c. A currency-accepting mechanism that is capable of allowing users to deposit a medium of currency. *See fig. 5(22-25), 6(18)*.
- d. A value-dispensing mechanism that is capable of dispensing value to a user. *See fig. 5(22-25), 6(37, 38)*.

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- e. A controller operatively coupled to the display unit, the input device, the currency-accepting mechanism, and the value dispensing mechanism where the controller comprises a processor and a memory operatively coupled to the processor. *See fig. 6(60); col. 4:64-5:33.*
- f. The controller being programmed to allow the user to make a wager via the input device after the currency-accepting mechanism detects deposit of currency by the user. *See col. 5:34-55.*
- g. The controller being programmed to cause the display unit to display a first sequence of images representing a main gambling game after the user makes a wager, the first sequence of images representing a main gambling game of video poker or video slots and at least one of the images comprising an images of at least five playing cards. *See col. 5:5-55.*
- h. The controller being programmed to determine, after the first sequence of images has been displayed, an outcome of the main game represented by the first sequence of images and to determine a currency payout associated with the outcome of the main gambling game. *See 4:64-5:33.*
- i. The controller being programmed to cause a second sequence of images to be generated on the display after detecting the triggering event, the second sequence of images representing a bonus round game. *See col. 3:27-46, 5:56-64.*
- j. The controller being programmed to determine, after the second sequence of images has been displayed, an outcome of the bonus round game represented by the second sequence of images and to determine a bonus payout associated with the outcome from the bonus round game. *See id.*
- k. The controller being programmed to cause the value-dispensing mechanism to dispense the bonus payout and not the currency payout to the user after the bonus payout has been determined and prior to returning to the main gambling game. *See id.*

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- l. The controller being programmed to return to the main gambling game at the conclusion of the bonus round game.

Hence the claims are unpatentable because *Schneider* anticipates each and every feature claimed.

Regarding claims 2, 10, 18, 26 and 34: *Schneider* teaches a currency-accepting mechanism comprises one of a coin slot, bill reader and electronic reader that is capable of reading an item having data stored thereon. *See col. 4:29-46.*

Regarding claims 7, 15, 23, 31 and 39: *Schneider* teaches a triggering event being a qualifying outcome which may be a combination of symbols. *See col. 2:60-62, 5:40-47.* A qualifying hand in a poker gaming device is may consist of either a combination of symbols, a single symbol or a combination thereof.

Claims 41 and 46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Schneider*.

Regarding claim 41: *Schneider* disclose a slot machine having a programmed memory configured in accordance with program instructions to perform the following features of the claims:

- a. A display unit capable of generating images associated with a main gambling game and bonus round game. *See fig. 16(14, 16); col. 4:28-46.* It is implicit that the display is a color display.
- b. An input device allowing the user to make a plurality of input selections. *See fig. 6(14, 16), 26.*
- c. A currency-accepting mechanism that is capable of allowing users to deposit a medium of currency. *See fig. 5(22-25), 6(18).*

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- d. A value-dispensing mechanism that is capable of dispensing value to a user. *See fig. 5(22-25), 6(37, 38).*
- e. A controller operatively coupled to the display unit, the input device, the currency-accepting mechanism, and the value dispensing mechanism where the controller comprises a processor and a memory operatively coupled to the processor. *See fig. 6(60); col. 4:64-5:33.*
- f. The controller being programmed to allow the user to make a wager via the input device after the currency-accepting mechanism detects deposit of currency by the user. *See col. 5:34-55.*
- g. The controller being programmed to cause the display unit to display a first sequence of images representing a main gambling game after the user makes a wager, the first sequence of images representing a main gambling game of video poker or video slots and at least one of the images comprising an images of at least five playing cards. *See col. 5:5-55.*
- h. The controller being programmed to determine, after the first sequence of images has been displayed, an outcome of the main game represented by the first sequence of images and to determine a currency payout associated with the outcome of the main gambling game. *See 4:64-5:33.*
- i. The controller being programmed to cause a second sequence of images to be generated on the display after detecting the triggering event, the second sequence of images representing a bonus round game. *See col. 3:27-46, 5:56-64.*
- j. The controller being programmed to determine, after the second sequence of images has been displayed, an outcome of the bonus round game represented by the second sequence of images and to determine a bonus payout associated with the outcome from the bonus round game. *See id.*

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- k. The controller being programmed to cause the value-dispensing mechanism to dispense the bonus payout and not the currency payout to the user after the bonus payout has been determined and prior to returning to the main gambling game. *See id.*
- l. The controller being programmed to return to the main gambling game at the conclusion of the bonus round game.

*Schneider* discloses all the limitations of a claim except having a separate memory configured to perform each of the functions above. The examiner cannot determine whether or not the *Schneider* inherently possesses properties which anticipate or render obvious the claimed invention. However, the burden of proof is shifted to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Hence the claims are unpatentable because they are either anticipated or obvious in view of *Schneider*.

Regarding claim 46: *Schneider* teaches a triggering event being a qualifying outcome which may be a combination of symbols. *See col. 2:60-62, 5:40-47*. A qualifying hand in a poker gaming device is may consist of either a combination of symbols, a single symbol or a combination thereof.

### ***Claim Rejections - 35 USC § 103***

Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schneider*.

*Schneider* discloses a gaming device having programmed memory means for storing computer-readable instructions. *See fig. 6(64)*. However, it does not disclose the programmed memory comprising a semi-conductor memory or an optically readable memory. Regardless, it is notoriously well known in to use semi-conductor memory or an optically readable memory to store program instructions in gaming devices. These types of memories are substitutable equivalents known in the art for the same purpose of storing computer-readable instructions in a non-volatile medium. Hence, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by *Schneider*, wherein a

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programmed memory stores computer-readable instructions, to substitute semi-conductor memory or an optically readable memory to store the computer-readable instructions in a non-volatile medium and thereby prevent loss or changes to the data.

Claims 3-5, 11-13, 19-21, 27-29, 35-37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schneider* in view of Walker et al., U.S. Patent 6,110,041 (Aug. 29, 2000)

In regards to claims 3, 5, 11, 13, 19, 21, 27, 29, 35, 37, 42 and 44: *Schneider* discloses all the features of the claims except dispensing the bonus payout based on user preference information stored on the item. *Walker* discloses a gaming system in which players' gaming machine preferences are associated with a tracking card. *See fig. 9-11(b); col. 2:13-53*. Based on the players' preferences the slot machine can be configured according to operative according to the players' preferences of, for example, game type, language or form of payout. *See col. 1:55-65*. In view of *Walker*, it would have been obvious to an artisan at the time of the invention to modify the gaming system described by *Schneider* to add the feature of dispensing the bonus payout based on user preference information stored on the item. As suggested by *Walker*, configuring a gaming system based on player preference increases player interest while reducing their frustration. *See id.* As a result, operator revenue would increase in accordance with increased player usage.

In regards to claims 4, 12, 20, 28, 36 and 43: *Walker* additionally teaches a player tracking system wherein the game controller is programmed to transmit data stored on a item to the player tracking system via an interface and to receive information related to the user associated with the item having data stored thereon from the player tracking system via the interface. *See id.*



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Claims 6, 14, 22, 30, 38 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schneider* in view of Burns et al., U.S. Patent 6,048,269 (Apr. 11, 2000) and Saunders et al., U.S. Patent 6,340,331 B1 (Jan. 22, 2002).

Regarding claim 6, 14, 22, 30, 38, 45: *Schneider* discloses all the features of the claim except a value dispensing mechanism that is a printing apparatus and the dispense value is an award ticket printed and dispensed by the printing apparatus and having indicia of at least one of casino name, ticket type, a validation number, a bar code, a date of issuance, a time of issuance, redemption instructions, redemption restrictions, and a description of the award.

*Burns* discloses a coinless gaming system wherein the value dispensing mechanism is a printing apparatus and the dispensed value is an award ticket printed and dispensed by the printing apparatus and having indicia including casino name (i.e. logo), ticket type, a validation number, a bar code, a date of issuance, a time of issuance and a description of the award. *See fig. 1-4*. *Saunders* discloses a similar system wherein printed tickets additionally include redemption instructions and redemption restrictions. *See fig. 1-3*.

In view of *Burns* and *Saunders*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify gaming system described *Schneider* to add a value dispensing mechanism that is a printing apparatus and the dispense value is an award ticket printed and dispensed by the printing apparatus and having indicia of at least one of casino name, ticket type, a validation number, a bar code, a date of issuance, a time of issuance, redemption instructions, redemption restrictions, and a description of the award. As suggested by *Burns*, the use of printed tickets enhances the gaming device by increasing convince and security for both the players and operators. *See col. 2:66-4:26*.

Claims 8, 16, 24, 32, 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schneider* in view Adams, U.S. Patent 6,113,098 (Sep. 5, 2000).

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The gaming system described *Schneider* discloses all the features of the claim except a value dispensed by the value dispensing mechanism being at least one of ticket redeemable for cash, a ticket for a show, a ticket for a meal, a ticket for casino services, a ticket for hotel services. *Adams* discloses a gaming system with a supplemental ticket dispenser wherein a gaming device that provides awards from a group consisting of coins, currency, credits or redeemable tickets. *See fig. 1; col. 1:32-46*. The tickets may be redeemed for various goods or services including meals, rooms, shows and free game play. *See col. 2:34-47*. In view of *Adams*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system described *Schneider* to add a value dispenser mechanism to dispense tickets redeemable for cash, a ticket for a show, a ticket for a meal, a ticket for casino services, a ticket for hotel services to enhance operators' revenues by marketing additional services to users by awarding them tickets redeemable for non-gaming goods and services and thereby induce users to spend more money at other portions operator's business.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any

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inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

S.a.

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700